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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/594,794	06/16/2000	Yoshihito Mizuta	2000 0757A	9888

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EXAMINER

JOLLEY, KIRSTEN

ART UNIT PAPER NUMBER

1762

DATE MAILED: 08/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/594,794

Applicant(s)

MIZUTA, YOSHIHITO

Examiner

Kirsten C Jolley

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 24-28,30-33,35-37,39,40,42 and 45-48 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 24,25,27,28,30,32,33,39,40,42 and 45-48 is/are allowed.
- 6) ☒ Claim(s) 26,31 and 35-37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION*****Response to Arguments***

1. Applicant's arguments filed June 3, 2004 have been fully considered. Applicant argues that the transfer initiating site is not the bottom-most surface of the loop shaped workpiece. Upon review of the specification, the Examiner acknowledges that the transfer initiating site is not where the workpiece is downwardly immersed and transfer initially occurs, but rather is a site on the workpiece which is at the surface of the transfer liquid on the upstream side in the relative movement direction of the transfer film which is initially contacted with the transfer film and is the site at which subsequent transfer of the transfer film starts (as defined on page 15 of the specification), and illustrated as reference z in the drawings such as Figure 3D. Therefore, the Examiner acknowledges that the process disclosed in the Background of Watanabe et al. does not meet the limitation "such that a circumference of a cross section of the loop shaped workpiece, taken in the thickness direction of the loop shaped workpiece, is substantially concurrently contacted with the transfer film at the transfer initiating site" (when a thickness direction is perpendicular to the loop shaped direction in which the workpiece extends, as also required by claim 45). For this reason, claim 45 is allowable over the prior art.

The Examiner notes, however, that the only position of the loop shaped workpiece that meets the above quoted limitation is a workpiece that is initially immersed to a depth of exactly half its height and is perpendicular to the transfer liquid surface -- the position illustrated in Figure 3D. When the workpiece is immersed to a depth other than half-

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way, or when it is immersed at an immersion attitude angle other than perpendicular to the surface plane of the transfer liquid, then the circumference of a cross section of the workpiece, taken in the thickness direction, is not substantially concurrently contacted with the transfer film at the transfer initiating site as required by claim 45. (The surface of the transfer liquid at the transfer initiating site would be at an angle and therefore the transfer film would not concurrently contact the circumference of the cross section, taken in the thickness direction.) It is noted that Figures 6B, 7B, and 8B illustrate positions that would not meet the limitation of claim 45. Similarly, claims 26, 31, and 35 are rejected under 35 USC 112, 2<sup>nd</sup> paragraph because the claims require immersion attitude angles which are contradictory to the above-quoted limitation of claim 45.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 26, 31, and 35-37 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 26, 31, and 35 require “an immersion attitude angle ... is set to be within a range of plus or minus 10 to 90 degrees.” This limitation is vague and indefinite because it is contrary to a claim limitation of independent claim 45, specifically “such that a circumference of a cross section of the loop shaped workpiece, taken in the thickness direction of the loop shaped workpiece, is substantially concurrently contacted with the

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transfer film at the transfer initiating site.” As discussed above, an immersion attitude angle other than perpendicular to the surface of the transfer liquid would result in a transfer film at the transfer initiating site that does not concurrently contact the circumference of the cross section, taken in the thickness direction.

#### ***Allowable Subject Matter***

4. Claims 24-25, 27-28, 30, 32-33, 39-40, 42, and 45-48 are allowed. The prior art does not teach or fairly suggest a method of immersing a loop shaped workpiece in a transfer film on a transfer liquid such that the workpiece is immersed to a depth exactly half of its height and is perpendicular to the surface plane of the transfer liquid. Such a position is the only position that meets the limitation of “a circumference of a cross section of the loop shaped workpiece, taken in the thickness direction of the loop shaped workpiece, is substantially concurrently contacted with the transfer film at the transfer initiating site” as required by claim 45, as discussed above in section 1.

#### ***Conclusion***

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kirsten C Jolley whose telephone number is 571-272-1421. The examiner can normally be reached on Monday to Thursday and every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive P Beck can be reached on 571-272-1415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Kirsten C Jolley  
Patent Examiner  
Art Unit 1762

kcj